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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,246	09/10/2003	H. Hoogland	294-79 DIV	3492
23869	7590	06/14/2005	EXAMINER	
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			TRUONG, THANH K	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/659,246	Applicant(s) HOOGLAND ET AL.	
	Examiner Thanh K. Truong	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's Divisional Application received on September 10, 2003.
2. Applicant's cancellation of claims 1-39 is acknowledged.

Drawings

3. The drawings are objected to because of the following informalities:

Figure 1 shows two views of the invention, and they should be re-number as two views (requires amending the specification to add brief drawing description).

Figure 2, the "A-A" should be changed to -- 2A-2A -- (requires amending the specification to add brief drawing description).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: the recitation "the present invention is characterized by the features of claim 1" (or 2, 3, etc.) in line 2 of page 2 is improper. The specification should not be referred to the claim, because in the process of the prosecution of the application, the claim may be canceled, amended or withdrawn, and the canceled (or amended or withdrawn) claim will render the disclosure indefinite or invalid. Other similar recitations through out the specification also need to be corrected. Appropriate correction is required.

5. The abstract of the disclosure is objected to because of the use of the ~~legal~~^{legal} phraseology such as "said" in line 1 and "means" in line 7. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 40-43, 50, 52, 55-58, 65, 67-71, 73-82, 85, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948).

Heiligers discloses a method for manufacturing a storage device (1) for plate-shaped data carriers (2), the storage device having a first and second cover (3, 5) pivotally connected (at 6 with the intermediate part 4), and loading the plate-shaped data carrier in the storage device.

Heiligers discloses the claimed invention, but does not expressly disclose the positioning of the authentication means in the injection molding part.

Foulkes discloses the in-mold labeling technique in which a pre-formed polymeric label is incorporated into a polymeric article by molding the article in a mold containing the label providing an attractive appearance article and the label is difficult to remove (column 1, lines 13-19).

Wolpert discloses that in-mold labeling is an effective authenticating means to prevent counterfeiting and to secure valuable merchandise (column 1, lines 17-40).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Heiligers' method by incorporating the in-mold labeling as taught by Foulkes and Wolpert providing an attractive article with authenticating means being injection molding within the part that is difficult to remove and preventing counterfeiting of the article.

Heiligers, Foulkes and Wolpert further disclose: the storage device is injection molded in one piece (Heiligers – figure 1); the authentication means (such as bar code 16, 46b – Wolpert, figures 4A and 8); providing a printing and placing the printing (such as bar code) in the molding part and form an integral part of the cover; the printing is introduced into the mold on a carrier (Wolpert, figure 4A); the authentication means is a magnetic means which is positioned on a carrier in the mold, and injecting plastic around the magnetic means, such that the carrier is enclosed therein; a fixing means or resilient fingers (17) within the storage device for fixing the plate shaped data carrier in the storage device (Heiligers, figure 2a), and the data carrier is a CD (2); and the hinge (6) forming an integrated one piece hinge between the first and second cover.

Regarding to claim 79, the examiner takes Official Notice that offering the data carrier house in the storage device to consumers for sale is obvious and well known. As Wolpert has clearly pointed out that the function of the authentication means is to prevent counterfeiting of the product and also to secure the "valuable merchandise" (column 1, lines 17-19), and the main purpose of the manufacturing industry is to

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produce products for sale in the markets for profit. Therefore, it would have been obvious to state that Heiligers, Foulkes and Wolpert further comprising offering the carrier housed in the storage device to consumer for sale.

8. Claims 53, 54 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948).

As discussed above in paragraph 7 of this office action, Heiligers, Foulkes and Wolpert disclose the claimed invention, but do not expressly disclose that the carrier having printing on two sides. The examiner takes Official Notice that it would have been obvious to provide a carrier having printing on both side so the printing (such as bar code) can be seen on both side without being turn around.

Regarding to claim 54, the carrier is at least partially transparent is inherent, because in order to read the bar code, the storage device need to be at least partially transparent.

9. Claims 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948).

As discussed above in paragraph 7 of this office action, Heiligers, Foulkes and Wolpert disclose the claimed invention, but do not expressly disclose the melting index of at least 30 and 50. It would have been obvious to one having ordinary skill in the art

at the time the invention was made to have performed the injection molding of Heiligers using the melt index as claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

10. Claims 44-49, 59-62 and 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948), and further in view of Hanamoto et al. (4,639,341).

As discussed above in paragraph 7 of this office action, Heiligers, Foulkes and Wolpert disclose the claimed invention, but do not expressly disclose the placing of the carrier adjacent a wall of the mold and inject the plastic to contact the carrier and the mold wall.

Hanamoto discloses a method in which the carrier (32) with the printing indicia (10) is placed adjacent a wall of the mold and the plastic is injected to contact the carrier and the mold wall (figures 1-7). Hanamoto provides an effective method to molding articles by injection molding while simultaneously imprinting or transferring patterns on a continuous sheet on or to the molded articles (column 1, lines 14-17).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Heiligers' method by incorporating the molding articles with printing pattern as taught by Hanamoto providing an effective molding process that produce printing pattern on the injection molding article.

Hanamoto further discloses: the stretching of the carrier before placing the carrier in the mold so that the carrier is pulled taut (column 3, lines 52-62); the carrier burn while the printing is incorporated on the plastic when the plastic is injected into the mold; the carrier fuses with the plastic; wherein the printing is designed as a transfer (column 1, line s 15-16).

11. Claims 51, 72 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986), Wolpert et al. (6,255,948), and further in view of Walters (5,815,292) and Palmer et al. (5,189,531).

As discussed above in paragraph 7 of this office action, Heiligers, Foulkes and Wolpert disclose the claimed invention, but do not expressly disclose that the printing further comprises providing a holographic printing.

Walters discloses that holograms are commonly used as authenticating devices because it provide a three-dimensional image, and thus it is difficult to reproduce (column 1, lines 15-17).

Palmer discloses that holograms are formed in moldable materials by utilizing injection molding can be applied to digital compact audio discs or video discs (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Heiligers, Foulkes and Wolpert method to include the hologram image as taught by Walters and Palmer to provide an authenticating devices that is difficult to reproduce.

Conclusion

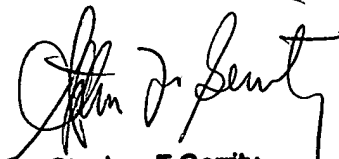
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tkt
June 12, 2005.



Stephen F. Gerrity
Primary Examiner